

**REMARKS**

At the time of the First Office Action dated June 28, 2007, claims 1-40 were pending and rejected in this application. Independent claims 1, 9, 17, 25, and 33 have been amended to respectively include the limitations previously presented in claims 4, 12, 20, 28, and 36, and consequently claims 4, 12, 20, 28, and 36 have been cancelled. Independent claims 1 and 25 have also been amended to include the limitations previously presented in claims 2 and 26, and consequently, claims 2 and 26 have been cancelled.

**CLAIMS 1-40 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY  
CONKLIN ET AL., U.S. PATENT NO. 6,338,050 (HEREINAFTER CONKLIN)**

On pages 2-5 of the Office Action, the Examiner asserted that Conklin discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.<sup>1</sup> Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.<sup>2</sup> As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify

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<sup>1</sup> In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

<sup>2</sup> See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

corresponding elements disclosed in the allegedly anticipating reference.<sup>3</sup> This burden has not been met.

At the outset, Applicants note that independent claims 1, 9, 17, 25, and 33 have been amended to respectively include the limitations previously presented in claims 4, 12, 20, 28, and

36. Specifically claims 4, 12, 20, 28, and 36 each recite the following limitations:

the contract is generated by:

storing at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract,

storing at least one terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules,

generating links between the compilation of business rules and the terms and conditions set to generate specific terms and conditions to be embodied in the contract, and

interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract.

On page 4 of the Office Action, to teach all of the above-reproduced limitations, the Examiner asserted the following:

(Conklin Col. 19, lines 38-56, "Sponsor 06 also monitors activity, collects fees, establishes standards or rules (or both) for the community, and promotes successes.").

For ease of reference, column 19, lines 38-56 is reproduced below:

The sponsor processes of FIG. 1g include maintaining databases, registering community and seller domain names, and submitting Web uniform resource locators (URLs) to multiple search engines so that both the community Website and each seller Website within it can be found by search engines such as Compaq's ALTAVISTA.TM. among others. Sponsor 06 also monitors activity, collects fees, establishes standards or rules (or both) for the community, and promotes successes. Once a deal is concluded it is archived 68, by multivariate negotiations engine 212 on behalf of seller. The present invention also allows the collection and analysis of direct e-mail demographic information, such as company name, title and location. This data helps the present invention screen out frivolous or fraudulent inquirers. For example, a high school student attempting to propose an order might be intercepted when the present invention determines that no company name or title has been provided and no other authorization for such a request has been provided for.

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<sup>3</sup> Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

Applicants respectfully disagree with the Examiner's analysis. In this regard, Applicants note the Examiner's rejection under 35 U.S.C. § 102 fails to comply with 37 C.F.R. § 1.104(c).<sup>4</sup> Although broadly identifying in Conklin where the Examiner believes the claimed limitations are disclosed, the manner in which the Examiner conveyed the statement of the rejection, however, has not "designated as nearly as practicable" the particular parts in Conklin being relied upon in the rejection.

For example, as claimed, the contract is generated is two separate storing steps, a generating step, and an interlocking step. However, the Examiner's cited passage is silent as to these specific limitations. Thus, the Examiner has failed to establish that Conklin identically discloses the claimed invention, as recited in independent claims 1, 9, 17, 25, and 33, within the meaning of 35 U.S.C. § 102. Applicants, therefore, respectfully submit that the imposed rejection of claims 1, 3, 5-11, 13-19, 21-25, 27, 29-35, and 37-40 under 35 U.S.C. § 102 for anticipation based upon Conklin is not factually viable and, hence, solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing

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<sup>4</sup> 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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